

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Appln. No. 09/874,314

Attorney Docket No. Q64575

REMARKS

Applicants herewith attach a copy of Form PTO-892 attached to the Office Action of August 13, 2002, as requested by the Examiner.

In the present Amendment, Claim 1 has been amended to delete the recitation “aliphatic/aromatic copolymer petroleum resins.”

No new matter has been added, and thus entry of the present Amendment is respectfully submitted to be proper. Upon entry of the Amendment, Claims 1 and 2 will be all the claims pending in the application.

Claims 1 and 2 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over Dobashi et al (U.S. Pat. No. 5,643,676).

Applicants respectfully submit that the amended Claims 1 and 2 are not anticipated or rendered obvious in view of Dobashi et al for at least the following reasons.

1. Present Invention is not Anticipated by Dobashi et al

Applicants respectfully traverse the Examiner’s assertion that the tackifiers of Dobashi et al expressly or inherently read on “hydrogenated aliphatic/aromatic copolymer petroleum resins” of the present invention.

Dobashi et al discloses “aliphatic, aromatic or alicyclic petroleum resins...and those modified by hydrogenation” as tackifiers. That is, the tackifiers may be aliphatic petroleum resins, aromatic petroleum resins, alicyclic petroleum resins, hydrogenated aliphatic petroleum resins, hydrogenated aromatic petroleum resins, and hydrogenated alicyclic petroleum resins.

In contrast, the resin used in the present invention is an aliphatic/aromatic copolymer petroleum resin, which is different from an aliphatic petroleum resin, an aromatic petroleum resin, or a mixture of aliphatic and aromatic petroleum resins.

Accordingly, Dobashi et al does not teach or anticipate the present invention.

2. Present Invention is not Obvious over Dobashi et al

Any possible *prima facie* case of obviousness has been overcome by the unexpected superiority of the present invention. In this regard, Applicants herewith submit a Declaration under 37 C.F.R. § 1.132 executed by Mr. Tsuyoshi Inoue, a co-inventor of the present invention. The Declaration clearly demonstrates the superiority and thus the patentability of the present invention.

In the Declaration, a sheet was prepared in the same manner as Example 1 of the present specification, except that the terpene resin of Dobashi et al (YS RESIN PX1150) was used in place of the styrene/hydrogenated terpene copolymer resin (Clearon K100). The sheet was evaluated in the same manner as described on page 19 of the present specification. The results obtained were compared with the results obtained in Examples 1 and 5 of the present application, wherein a styrene/hydrogenated terpene copolymer resin and a hydrogenated aliphatic/aromatic copolymer petroleum resins were used, respectively.

As is apparent from the comparative data, the film prepared using the resin of Dobashi et al cannot prevent occurrence of fouling. That is, the present invention provides unexpectedly superior results relative to Dobashi et al, in terms of the fouling property, and is not obvious over Dobashi et al.

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In view of the above, the Examiner is respectfully requested to reconsider and withdraw the rejection.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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